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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/341,590	07/12/1999	BJARNE DUE LARSEN	55508 (45487)	5316

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EXAMINER

LUKTON, DAVID

ART UNIT PAPER NUMBER

1653

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/341,590

Applicant(s)

LARSEN, BJARNE DUE

Examiner

David Lukton

Art Unit

1653

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 8/18/04 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL *before*

2. ☒ The reply was filed ~~after~~ the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on 29 November 2004. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached sheets. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 83,87,88,90,101 and 102.
Claim(s) objected to: _____.
Claim(s) rejected: 109.
Claim(s) withdrawn from consideration: 82,89,91-100,104-108,110 and 111.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Advisory Action

The amendment filed 8/18/04 directs the cancellation of claims 82, 89, 91-100, 104-108, 110, 111, and the addition of claims 115-134.

However, this amendment will not be entered.

In the response filed 8/18/04, applicants have asserted that claim 115 is the same as claim 82 (as presented at the time of the final rejection) with the exception that the following peptide has been added to the genus: YGGFLKKKKKK.

However, this assertion is not correct. First, claim 82 (as filed on 5/4/04) was drawn to a peptide conjugate consisting of X and Z, rather than to a peptide conjugate comprising X and Z, as claim 115 recites. Second, claim 115 probably constitutes new matter. Claim 115 is drawn not to "X" per se, but rather to a conjugate that comprises X and Z. Accordingly, claim 115 as rendered does not encompass the peptide YGGFLKKKKKK, since substituent "Z" must be bonded to the C-terminus of YGGFLKKKKKK. By reciting that "X" can be the peptide YGGFLKKKKKK, claim 115 recites a new subgenus that was not previously recited. Some examples of the members of this genus are the following (for the case of $p = 2$):

YGGFLKKKKKKYNKK

YGGFLKKKKKKDRKKKKKKKKKKKKKK

YGGFLKKKKKKKKKYN

YGGFLKKKKKKKKKKKKKKKKKKKKDR

It does not appear that there is descriptive support for any of these species, or for any compound falling within the scope of the new subgenus that has been created. But in any case, claim 115 does not encompass the elected specie.

Another reason for denying entry of the amendment concerns claim 132. Applicants have argued that the wording of this claim is merely an attempt to comply with the §112, second paragraph rejection that was applied against claim 109. However, the scope of claim 109 was constrained by the description of claim 83; claim 109 had to be subgeneric thereto. Currently, there are numerous embodiments of claim 132 which do not fall within the scope of claim 83. In particular, claim 132 encompasses amino acids and dipeptides. As applicants will no doubt recognize, all of the amino acids encompassed by claim 132 are well known in the (prior) art. Furthermore, most of the di- and tri-peptides encompassed by claim 132 are also well known in the art. Accordingly, a new search would have to be conducted for all of the amino acids, all of the dipeptides, tripeptides (etc.) that are encompassed by claim 132.

Entry of the amendment would require new consideration and a new search.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber, can be reached at 571-272-0925. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.


DAVID LUKTON
PATENT EXAMINER
GROUP 1800